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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,262	05/11/2001	Luc Wuidart	S1022/8664	5046

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EXAMINER

TRAN, TUAN A

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,262

Applicant(s)

WUIDART, LUC

Examiner

Tuan A Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 15-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 12-14 is/are rejected.
- 7) ☒ Claim(s) 9-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

Newly submitted claims 15-37 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 15-37 drawn to a method and system for detecting whether a transponder is present in an electromagnetic field by a comparison process that is distinct from the original claimed invention of claims 1-11 that drawn to a structural method and apparatus of a terminal adapted to communicate with a transponder comprising means for regulating a signal phase; means for measuring variables linked to current and voltage of a oscillating circuit and means for comparing these measured variables with threshold values

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-37 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 09/854,144. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-8 of the instant application are various wording of claims 1-8 of the copending Application No. 09/854,144. For example, the terminal of claims 1-2 of the copending Application No. 09/854,144 including: an oscillating circuit; a demodulator; means for regulating a signal phase; means for measuring variable linked to a current in the oscillating circuit and the voltage thereacross; means for deactivating the phase regulation means; and means for forcing a value of a settable element of the oscillating circuit as specified in claims 1-2 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

1. Claims 1-8 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Wuidart et al. (6,650,226).

Regarding claims 1 and 12, Wuidart discloses a terminal for generating an electronic field adapted to communicating with at least one transponder entering this field, including: an oscillating circuit R1, L1 and 24 adapted to being excited by a high-frequency remote supply signal of the transponder (See fig. 4 and col. 6 lines 12-27); a phase demodulator for detecting possible data transmitted by the transponder by modulating, at a rate of a sub-carrier, a load that it forms on the terminal's oscillating

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circuit (See fig. 4 and col. 5 lines 43-46, col. 6 lines 4-11); means for regulating a signal phase in the terminal's oscillating circuit in response to a reference value having a long response time as compared to the sub-carrier (See fig. 4 and col. 6 line 32 to col. 7 line 42); means 35, 34 for measuring variables linked to a current in the oscillating circuit and to the voltage thereacross (See figs. 7, 9 and col. 9 lines 1-13, 20-37); means for comparing present values of these variables with predetermined values (See figs. 8, 10 and col. 9 lines 14-19, 38-42); and a circuit to determine the presence of a transponder in the terminal's field by exploiting the results of the comparison means (See figs. 7-8 and col. 9 lines 1-20).

Claim 5 is rejected for the same reasons as set forth in claims 1 and 12, as method.

Regarding claims 2-4, Wuidart discloses as cited in claim 1. Wuidart further discloses means for deactivating the phase regulation means (See fig. 4 and col. 6 lines 49-63) and means for forcing a value of a settable element of the oscillating circuit, wherein the settable element is formed of a variable capacitive element of the oscillating circuit of the terminal and is common to the phase regulation means and the forcing means (See fig. 4 and col. 6 lines 28-53).

Claims 7-8 are rejected for the same reasons as set forth in claims 2-4, as method.

Regarding claim 13, Wuidart discloses as cited in claim 12. Wuidart further discloses the circuit comprises a microprocessor 6 (See fig. 7).

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Regarding claim 14, Wuidart discloses as cited in claim 1. Wuidart further discloses the predetermined values correspond to values measured and stored during an off-load operation of the terminal, while no transponder is present in its field (See fig. 8 and col. 9 lines 14-20).

Claim 6 is rejected for the same reasons as set forth in claim 14, as method.

Allowable Subject Matter

2. Claims 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claims 9-11, Wuidart discloses as cited in claim 8. However, Wuidart does not mention the steps of: calculating a present imaginary part of an impedance of the terminal's oscillating circuit; comparing a present absolute value of this imaginary part with a predetermined limiting value as specified in claims 9.

Response to Arguments

Applicant's arguments filed 09/27/2004 have been fully considered but they are not persuasive.

- a. The Applicant argued that "Wuidart describes regulating a current phase of the oscillating circuit by comparing a present value of the measured current in the oscillating circuit with the present value of the reference signal REF, not a predetermined value. Further, although Wuidart describes measuring the voltage in the

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oscillating circuit, Wuidart does not disclose comparing this voltage to any value" (See Remark, page 12-13). The Examiner respectfully disagrees with the Applicant's arguments because Wuidart does disclose means for comparing present values of the variables linked to current and voltage in the oscillating circuit with predetermined values (See figs. 8 and 10 and col. 9 lines 14-43). For that reasons, the Examiner remains the same rejections for all pending claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan Tran** whose telephone number is **(703) 605-4255**.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vivian Chin**, can be reached at **(703) 308-6739**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



Tuan Tran

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MARCEAU MILORD
PRIMARY EXAMINER